

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:	Atty. Docket No.:	007287.00043
<b>Dan Kikinis <i>et al.</i></b>		
Serial No.: 09/661,164	Group Art Unit:	2424
Filed: September 13, 2000	Examiner:	Joseph G. Ustaris
For: SYSTEM AND METHOD FOR INSERTION OF RECORDED MEDIA INTO A BROADCAST	Confirmation No.:	7516

**REPLY BRIEF**

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Sir:

This *Reply Brief* is filed pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed September 2, 2009. Because Appellants believe that the examining corps' errors are readily ascertainable on the briefs, Appellants do not request an oral hearing at this time. However, if the Board of Patent Appeals & Interferences believes that an oral hearing would be beneficial, the Board is invited to contact Appellants' undersigned representative at (202) 824-3156.

***Remarks***

The Examiner's Answer at pp. 3-17 merely repeats the rejections in the final Office Action, and these rejections were fully addressed in Appellants' Appeal Brief filed May 26, 2009. This Reply Brief addresses the "Response to Argument" beginning on page 15 of the Examiner's Answer.

The clearest flaw in the rejection of claim 1 under 35 U.S.C. § 103(a) is that no reason *with a rational underpinning* for combining Gordon with Reynolds and/or Sigmond is provided. The Examiner's Answer states that the combination would yield a predictable result for the

incentive of allowing a system to dynamically adjust how to distribute programs based on viewing trends and events. Examiner’s Answer at p. 4. However, such an assertion fails to consider why one of ordinary skill in the art would place the intelligence for resolving priority conflicts (as discussed in Gordon) in the *set-top box receivers* of the Gordon system. As noted in Appellants’ Appeal Brief, Appellants submit that it would not have been obvious to combine the references in the asserted manner because the purpose of Gordon is to alleviate bandwidth and storage requirements of an interactive television network by using local servers (i.e., not set-top box receivers) to resolve priority conflicts and to store subsets of data objects. *See, e.g.*, para. [0011]. Placing such a burden on the set-top boxes in Gordon runs counter to the intended purpose of Gordon and would render Gordon unsuitable for its intended purpose. Accordingly, claim 1 is allowable for at least these reasons.

Claims 11 and 26 recite features similar to those discussed above with respect to claim 1 and are thus allowable for at least the same reasons as claim 1.

Claims 2-10, 12-19, 27-34, 37 and 38 are dependent claims and are thus allowable for at least the same reasons as their respective base claims and further in view of the novel and non-obvious features recited therein.

Additionally, with respect to claim 38, the Examiner’s Answer states that “reading the claim in the broadest sense, Reynolds in view of Gordon, Zigmond and Robinett does disclose those limitations in the claims.” Examiner’s Answer at p. 16. In particular, the Examiner’s Answer asserts at p. 16 that Robinett’s alleged description of delaying the insertion of a changed PID mapping until a new/modified version of a PMT or CAT is available reads on delaying the insert of separate media into a broadcast stream until a first priority indicator is modified, as recited in claim 38. However, as noted previously, neither the changed PID mapping nor the PMT or CAT constitutes *separate media* as recited in claim 38. In response, the Examiner’s Answer states that “[i]t is also noted that Reynolds discloses separate media that is inserted (or used to replace items) in a broadcast stream.” Examiner’s Answer at p. 17. Even assuming, without conceding, that Reynolds describes the insertion of separate media, there is no rational underpinning for inserting separate media in a broadcast stream in the same manner as inserting PID mappings as described in Robinett. Indeed, neither the Final Rejection nor the Examiner’s Answer provides any rationale for delaying inserting separate media into a broadcast stream (as

allegedly described in Reynolds) until a new/modified version of a PMT or CAT is outputted (as allegedly described in Robinett).

Furthermore, Appellants note that the Examiner's assertion that Robinett describes delaying insertion of a changed PID mapping until a new/modified version of the PMT or CAT is *available* is not supported by Robinett's disclosure. Instead, Robinett states that any changes to PID mapping are preferably delayed until a new version of the PMT can be *outputted*. Col. 32, line 56 – Col. 33, line 7. Thus, not only does the PMT or CAT fail to describe a priority indicator, Robinett does not teach or suggest that insertion is delayed until the PMT or CAT is modified. That is, outputting does not constitute modifying. Stated differently, Robinett does not teach or suggest that PID mappings (i.e., the alleged separate media) are delayed until the PMT (i.e., the alleged priority indicator) is modified or that a new version of the PMT is created. The Examiner's Answer asserts that "Robinett discloses outputting a new version of the PMT or CAT when it's available." Applicants note that Robinett offers no support for this assertion. Claim 38 is thus allowable for these additional reasons.

### **CONCLUSION**

Appellants believe that the above reasoning presents the clearest arguments for overturning the rejection. For all the foregoing reasons, and based on the previously submitted arguments, Appellants respectfully request that the Board instruct the examining corps to withdraw the rejections and pass this case to issuance at its earliest convenience. If there are any questions or any additional information is required, please contact Appellants' undersigned representative at (202) 824-3156.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

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